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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,518	03/08/2004	Hung - Chi Hsu	14280 B	1937
23595	7590	08/11/2005	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402				LANDRUM, EDWARD F
		ART UNIT		PAPER NUMBER
		3724		

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/796,518	HSU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Edward F. Landrum	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-13 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Priority***

1. The applicants' claim no foreign or domestic priority.

### ***Information Disclosure Statement***

2. No IDS has been filed by the applicants.

### ***Specification***

3. The abstract of the disclosure is objected to because of legal phraseology such as "thus" and "thereby". Correction is required. See MPEP § 608.01(b).
4. Page 4, lines 19-22 of the disclosure are objected to under 37 CFR 1.71, as being incomprehensible. For example, the following items are not understood:

It is not understood why the laser light source needs to have a planar shape, how/why a light source can be used to tell if the blade is being kept at a vertical state, and why the ability to align with a transverse edge would be helpful when many cuts made by this invention would not have a transverse edge perpendicular to the cutting line. Appropriate action is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not clearly describe the effective use of the transverse light emitting source of the light emitting member. It is not understood why the laser light source needs to have a planar shape, how/why a light source can be used to tell if the blade is being kept at a vertical state, and why the ability to align with a transverse edge would be helpful when many cuts made by this invention would not have a transverse edge perpendicular to the cutting line.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear how the light aligns with a transverse edge of the work piece when the handsaw is moving away from said edge.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 5, 6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Myerchin et al (U.S Patent No. 5,727,319).

Regarding claim 1, Myerchin teaches a pocketknife with a handle (12), a blade (14), and a light source (50) attached to the handle (Col. 2, lines 45-60; Col. 3, lines 46-49; also see Figure 2). In as much structure set forth by the applicant, the device in Myerchin'319 is a handsaw (see MPEP 2112.01)

Regarding claims 5 and 6, Myerchin teaches a compartment (40 and 42) on a side of the handle where the light emitting member is mounted (Col. 3, lines 8-12; also see Figure 3) and a light switch (22) mounted on the side of the compartment to control operation of the light emitting member (Col. 2, lines 54-57; also see Figures 1,2, and 4).

Regarding claim 9, Myerchin teaches the blade (14) has different shapes (see Figure 3).

11. Claims 1,2,4,5,7,8,10,11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Webb (U.S Patent No. 5,675,899).

Regarding claim 1, Webb teaches (see Figures 1 and 2) a handle (12 and 16), a blade (14) attached to the handle and a light emitting member (23, 24, and 25) mounted on the handle to produce a longitudinal light source aligning with a lower edge of the blade and extending outward from the lower edge of the blade. In as much structure set forth by the applicant, the device in Webb is a handsaw (see MPEP 2112.01)

Regarding claim 2, Webb teaches the light emitting member is a laser light (Col. 2, lines 1-6).

Regarding claim 4, Webb teaches the laser can be operated on battery power (Col. 3, lines 37-39).

Regarding claim 5, Webb teaches the light emitting member may be placed within a chamber (20) on the side of a handle (Col. 2, lines 45-58; also see Figures 1 & 2).

Regarding claims 7 and 8, Webb teaches the light emitting member can be projected onto the surface of a work piece to align with a sawing line of the work piece. The light emitting member can also be directed in the same direction as the saw line (Col. 3, lines 3-11).

Regarding claims 10, 11, and 13, Webb teaches a transverse laser light source that moves with the blade and can align with the transverse edge of a work piece (Col. 3, lines 11-31). The light source can also be oriented to be perpendicular to the longitudinal light source of the light emitting member.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Myerchin in view of Chen '414 (U.S Patent No. 5,626,414).

Myerchin teaches all of the elements of the current invention as stated above except that the light emitting member is a laser light.

Chen '414 teaches a laser on a pocketknife which can be replaced with another light emitting member (Col. 3, lines 43-45).

It would have been obvious to have modified Myerchin to incorporate the teachings of Chen '414 to provide several options for the type of light emitting member used in the pocketknife, therefore, increasing the overall utility of the knife.

14. Claims 3, 6, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb in view of Wu (U.S Publication No. 2004/0049927 A1).

Webb teaches all of the elements of the current invention as stated above except for the planar shape of the light emitting member.

Wu teaches a light emitting member on a saw can have a planar shape (Col. 4, paragraph 28, also see Figure 1). Wu also teaches a switch on the handle of a saw for the light emitting member (Col. 1, paragraph 8).

It would have been obvious to have modified Webb to incorporate the teachings of Wu to provide a light emitting member, having a planar shape, and able to turn on and off with the use of a switch. A planar laser line would be visible above the cut line on the work piece and, therefore, would be more visible while cutting. A light switch would allow the user to conserve battery power when the light emitting member was not necessary.

15. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Webb in view of Buchholz (U.S Patent No. 6,632,131).

Webb teaches all of the elements of the current invention as stated above except for the blade having different shapes.

Buchholz teaches that a blade for a rotary saw can change shape by adding sections of sandpaper to the sides of the blade (Col. 2, lines 60-67; Col. 3, lines 1-7; and see Figures 1-6).

It would have been obvious to have modified Webb to incorporate the teachings of Buchholz to provide the saw with the ability to use blades of different shapes. Adding sections of different grade sandpaper to sections of the blade would not only help create a cut in the work piece but sand and polish the cut as well.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chen '256 (U.S Patent No. 5,467,256) and Chen '505 (U.S Patent No. 6,041,505) teach an illuminating knife device. McCalla et al (U.S Patent No. 6,419,371) teaches a lighted tool with interchangeable blades. Peot et al (U.S Patent No. 6,755,107) teach a saw with a handle and a laser alignment system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward F. Landrum whose telephone number is 571-272-5567. The examiner can normally be reached on Monday-Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EFL  
8/5/05



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